

2. REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 30-37, 39-46, 48-52, 54 and 56-59 are now pending in this application.

Claim Objections

On page 2 of the Office Action, the Examiner states:

Claims 30-37, 39-46, 48-52, 54 and 56-59 are objected to for usage of the functional language “configured to”. It is believed that Applicants intend “configured to” to mean “programmed to” since “configured to” is functional language and therefore given less patentable weight. In light of the notice function of the claims, the Examiner respectfully requests changing “configured to” to “programmed to” where a positive recitation is desired. See Also MPEP 2106.

Applicants respectfully disagree with the objection. “configured to” is appropriate language following “a location circuit” and “a data processor.”

MPEP 2106 raises questions as to “adapted to” or “adapted for” language, but does not state that “configured to” is improper. In addition, “configured to” language limits the scopes of claims. For example, claim 30 recites “a location circuit configured to provide location data based at least in part on the location of the handheld computer[.]” The “configured to” language limits the claim scope by limiting the structure of the location circuit to one that provide location data based at least in part on the location of the handheld computer. If the objection is sustained, a clarification about why “configured to” language is inappropriate is respectfully requested.

Claim Rejections – 35 U.S.C. § 103

1. Claims 30-46

On page 3 of the Office Action, claims 30-54 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,292,147 to Ham (Ham) and U.S. Patent No. 6,959,282 to Kakiyama et al. (Kakiyama) in view of U.S. Patent No. 7,376,586 to Partovi et al. (Partovi). The rejection is respectfully traversed.

Claim 30 recites:

30. A system for pricing a product, comprising:
a handheld computer comprising (a) a location circuit configured to provide location data based at least in part on the location of the handheld computer and (b) a wireless transceiver configured to provide wireless communication of the location data and a user identifier; and
a data processor configured to receive the location data and the personal identifier and to adjust a price lower for the product for a person associated with the user identifier based at least in part on the location data.

The Office Action does not explicitly state which prior art has disclosed a data processor configured “to **adjust a price lower** for the product for a person associated with the user identifier based at least in part on the location data.” Emphasis added.

Applicant respectfully submits that none of the prior art has disclosed this feature.

For example, Kariyama is directed to a toll collection arrangement. (Kariyama, Abstract.) Charges are made when a vehicle enters the charging area for the first time from the buffer area. (Kariyama, Abstract.) Therefore, the location of the vehicle is used to determine whether a toll should be paid. There is no disclosure or suggestion in Kariyama that the price of the toll is adjusted lower based on the location of the vehicle.

Partovi is directed to a voice portal supporting telephone to web server commerce. (Partovi, Abstract.) The voice portal allows a user to access web servers to complete the

transaction. (Partovi, Col. 14, lines 14-32.) There is no disclosure or suggestion in Partovi that the prices of the purchased products are adjusted lower based on the location of the telephone.

The Ham reference is directed to a self-positioning GPS antenna, which can be incorporated into a cellular phone. (Ham, col. 3 lines 11-13). Ham fails to provide any description of adjusting a price lower for a product based on location data.

Accordingly, Claim 30 is believed to be patentable over the cited references.

Claim 30 is believed to be further patentable over the cited references because the combination of Ham, Kakihara and Partovi is improper.

The Office Action states:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Ham and Kakihara by including the limitation detailed above as taught by Partovi because this would allow insurance company to identify the location of a user.

(Office Action, p. 4). It is respectfully submitted that the Office Action does not provide an articulated reasoning having a rational underpinning for combining the Ham, Kakihara and Partovi references. Pursuant to MPEP 2141, Section III:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396.

The Office Action states that the “navigation system for cars of Ham” can be modified “by including an insurance product or company that is connected to the navigation system as taught by Kakihara Murakami.” This combination, however, would result in combining a

navigation system for cars of Ham with a navigation system mounted in a vehicle of Kakihara. Even if this combination were proper, it would not teach a handheld computer as recited in Claim 30. Thus, the Office Action does not provide an articulated reasoning having a rational underpinning for combining the Ham and Kakihara references to arrive at the system of Claim 30.

Further, the combination of Ham and Kakihara would destroy the intended purpose of the system of Kakihara. Kakihara's navigation system is an "in-vehicle device" having a GPS antenna "mounted on the vehicle." (Kakihara, col. 39 lines 12 and 48). The navigation system must be mounted on the vehicle in order to serve the purpose of providing a "toll collection arrangement based on the position and travel of a vehicle." (Kakihara, Abstract). If components of the Kakihara system are moved into the cellular phone of Ham, the intended purpose of Kakihara (e.g., improved toll collection for a vehicle) would be destroyed. The modified device could be removed from the car, frustrating the purpose of reliable toll collection for a vehicle.

Accordingly, reconsideration and withdrawal of the rejection of Claim 30 is respectfully requested.

Claim 39 has recited, among other things, "pricing the product based on the location of the handheld computer and the personal identifier, wherein the step of pricing comprises generating a lower price for the product for a person or handheld computer associated with the user identifier." For the reasons that claim 30 is allowable, claim 39 is allowable.

Claim 48 has recited, among other things, "a data processor configured to determine a price for the product based at least in part on the location data received by the transceiver, wherein the price is determined at least in part by adjusting a price lower for the product for a person or handheld computer associated with the user identifier." For the reasons that claim 30 is allowable, claim 48 is allowable.

Claims 31-37 are dependent from claim 30. Claims 40-46 are dependent from claim 39. Claims 49-52, 54 and 56-59 are dependent from claim 48. Therefore, claims 31-37, 40-46, 49-52, 54 and 56-69 are allowable for at least the reasons that claims 30, 39 and 48 are allowable.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By /Fan Liang/ _____

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 319-7317
Facsimile: (414) 297-4900

Fan Liang
Attorney for Applicant
Registration No. L0556